



Attorney Docket No. 60117.000004
Attorney Customer No. 21967

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

Jens PETERSEN

Serial No.: 09/938,669

Filing Date: August 27, 2001

Group Art Unit: 1615

Examiner: Carlos A. Azpuru

Title: POLYACRYLAMIDE HYDROGEL AS A SOFT TISSUE FILLER
ENDOPROSTHESIS

MAILSTOP PETITION

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R. § 1.182
TO WITHDRAW TERMINAL DISCLAIMERS

Sir:

Under 37 C.F.R. § 1.182, Applicant hereby petitions to withdraw the terminal disclaimers recorded in the U.S. Patent and Trademark Office in the above-captioned application (the Application). A check in the amount of \$130.00 is enclosed to cover the petition fee under 37 C.F.R. § 1.17(h).

M.P.E.P. § 1490 at 1400-102 (8th ed., rev. 2) states:

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 C.F.R. 1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered.

Terminal disclaimers were filed in the Application on May 24, 2004 to overcome a provisional obviousness-type double patenting rejections of claims 27-31 over claims 18 and 19 of copending U.S. Application No. 09/938,667, claims 13-15 of copending U.S. Application No. 09/938,670, and claims 27-35 of copending Application No. 09/938,668. Office Action, pp. 2-5 (Feb. 24, 2004).

01/21/2005 HMEKONEN 00000030 09938669

01 FC:1814

130.00 DP

01/24/2005 HMEKONEN 00000087 500206 09938669

130.00 DP

270.00 DA

01 FC:1462

Applicant is not seeking to reopen the question of the propriety of the obviousness-type double patenting rejections that prompted the filing of the terminal disclaimers. On the other hand, Applicant respectfully submits that the claims have been amended in the Application, as well as the copending applications, since the time the terminal disclaimers were filed. Therefore, the terminal disclaimers are no longer proper or required. Specifically, claims 18 and 19 of copending U.S. Application No. 09/938,667 were canceled in an Amendment filed December 14, 2004. Claims 13-15 of copending U.S. Application No. 09/938,670 were canceled in an Amendment filed December 13, 2004. Claims 27-34 of copending Application No. 09/938,668 are withdrawn from consideration and claim 35 was canceled in an Amendment filed May 28, 2004.

The amendments in the Application and co-pending applications created circumstances appropriate for the nullification (also referred to herein as "withdrawal") of the terminal disclaimers. Claims 27-31 in the Application are directed to a prosthetic device for soft tissue augmentation (as they were on May 24, 2004) but they were amended on December 22, 2004 to recite certain additional details, such as the monomeric units content, and that the device is injectable into soft tissue. All pending claims being examined in U.S. Application 09/938,667 are directed to a method of treating incontinence or vesicoureteral reflux comprising administering a hydrogel or an endoprosthesis which includes a hydrogel (defined in the claims). All pending claims under examination in U.S. Application 09/938,670 are directed to a biostable hydrogel for use as an endoprosthesis. However, the hydrogel, as described in the claims of U.S. Application 09/938,670, does not render obvious the device claimed in the Application (i.e., a prosthetic device that is injectable into soft tissue). This is underscored by the fact that the obviousness-type double patenting rejection was based only on claims 13-15 (both now cancelled) of U.S. Application 09/938,670. All pending claims being examined in U.S. Application No. 09/938,668 are directed to a method for replacing, mimicking or augmenting a function of cartilage, synovial fluid or both, comprising administering an endoprosthesis to a joint in a mammal (the prosthesis comprising a hydrogel defined in the claims).

In addition, a Notice of Allowance in the Application was mailed on January 6, 2005. Moreover, the Examiners for copending Application Nos. 09/938,668 and 09/938,670 have

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indicated in Examiner Interviews held on December 9, 2004 and December 8, 2004, respectively, that those applications would also be allowed after filing amendments. Amendments were filed on December 13, 2004 in Application No. 09/938,670 and on January 7, 2005 in copending Application No. 09/938,668.

Accordingly, Applicant respectfully requests that the terminal disclaimers be withdrawn.

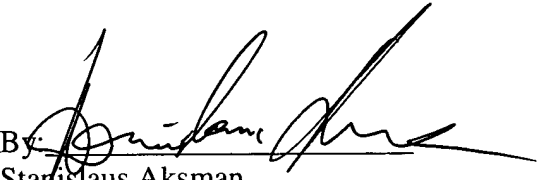
CONCLUSION

For at least the reasons stated above, Applicant requests that the recorded terminal disclaimers be withdrawn from the Application.

It is believed that no additional fees are due. However, if it is determined that any other fees are required, the Commissioner is authorized to charge such fees to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

Date: January 18, 2005

By: 
Stanislaus Aksman
Registration No. 28,562

HUNTON & WILLIAMS, LLP
1900 K Street, N.W.
Washington, DC 20006-1109
(202) 955-1926 telephone number
(202) 778-2201 facsimile number